

Supreme Court, U. S.
FILED

SEP 14 1977

MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1977

No. 77-403

IN RE:

AMALGAMATED DEVELOPMENT CO., INC. t/a WASHINGTON PATENT OFFICE SEARCH BUREAU and H. LAWRENCE BLASIUS,

Petitioners,

-against-

COMMITTEE ON UNAUTHORIZED PRACTICE, DISTRICT OF COLUMBIA COURT OF APPEALS,

Respondent.

**PETITION FOR WRIT OF CERTIORARI TO
THE DISTRICT OF COLUMBIA COURT OF APPEALS**

HARRY GROSSMAN
Attorney for Petitioner
515 Madison Avenue
New York, N.Y. 10022
(212) 752-4220

TABLE OF CONTENTS

	<i>Page</i>
Petition	1
Opinions of the Courts Below	2
Jurisdiction	2
Questions Presented	2
Statement of the Case	3
Reasons for Granting the Writ	8
I—The Recent Decision of This Court in <i>Bates v. State Bar of Arizona</i> , 97 S. Ct. 2691 Compels a Reversal of the Court Below with Regard to Petitioner, H. Lawrence Blasius	8
II—An Analysis of the Case of <i>Hull v. United States</i> , 390 F. 2d 462 Indicates that the Activities Engaged in by the Petitioner, Amalgamated Development Co., Inc., t/a Washington Patent Office Search Bureau Are Authorized and not Contrary to any Law	10
III—Any Question Dealing with any Type of Patent Law Practice is Vested in the Commissioner of Patents Only	13
IV—What Petitioner Amalgamated Development Co., Inc., t/a Washington Patent Office Search Bureau is Doing in its Business Relationships with Prospective Inventors Does not Constitute the Practice of Law	19

	<i>Page</i>
V—Preparation of Patent Applications or the Holding out of Being Able or Qualified to Prepare Such Applications is not a Violation of Section 33 and Does not Constitute the Practice of Law	22
Conclusion	26
Appendix A—Opinion and Order Decided June 20, 1977	1a
Appendix B—Order Dated May 14, 1976	12a
Appendix C—Order to Show Cause	22a
Appendix D—Answer	26a
AUTHORITIES CITED:	
<i>Arnesen v. Raymond Lee Organization, Inc.</i> , 333 F. Supp. 116 (1971—D.C. Cal.)	17
<i>Bates v. State Bar of Arizona</i> , 97 S. Ct. 2691 (decided June 27, 1977)	2,9
<i>Battelle Memorial Institute v. Green et al</i> 29 Ohio Opinions (2d) 388, (1962—Ohio Appeals Court, Tenth District, Franklin County)	14
<i>Enders v. American Patent Search Company, et al.</i> , 535 F. 2d 1085 (1976—9th Cir.) cert. denied 97 S. Ct. 242 (1976)	18
<i>Hull v. United States</i> , 390 F. 2d 462 (1968)	2,7,10
<i>In Re Battelle Memorial Institute</i> (Unauthorized Practice of Law—29 Ohio Opinions (2d) 388 (1962—Ohio Appeals Court, Tenth District, Franklin County)	14

	<i>Page</i>
<i>In Re Blasius</i> , 138 U.S. P. Q. 482 [Comm. Pats. 1961]	9
<i>People v. Miller</i> , 23 A.D. 2d 144, 146, 147 (1965—1st Dept.)	21
<i>Silverman v. State Bar of Texas</i> , 405 F. 2d 410 (1968—5th Cir)	17
<i>Sperry v. Florida</i> , 33 U. S. 379 (1963)	10
<i>Supreme Court of Florida</i> , 140 So. 2d. 587	20
<i>U.S. v. Blasius</i> , 393 U.S. 1008, 89 S. Ct. 615, 21 L. Ed. 557 (1969)	6
STATUTES CITED:	
Rule 46 II (b)—General Rules of District of Columbia Court of Appeals	7
Title 2—District of Columbia Code, Sec. 2-901	22
Title 2—District of Columbia Code, Sec. 2—1101, 1102, 1114 (1961 ed.)	23
Title 28, U.S. Code, Sec. 1254(1)	2
Title 35, U. S. Code, Sec. 11a	25
Title 35, U. S. Code, Sec. 33	25
United States Constitution—Article VI	14
BULLETINS:	
U. S. Civil Service Commission—Announcement No. 2-21-3 (1960) Issued March 23, 1960	23-24

	<i>Page</i>
U. S. Civil Service Commission—Announcement No. AT 35-1 (65) X-118 GS—1221 Issued 1/6/65	24
U. S. Patent Office—General Information Concerning Patents June 1960 (Reprint of November 1963) . . .	25

IN THE
SUPREME COURT OF THE UNITED STATES
OCTOBER TERM 1977

NO.

IN RE:

AMALGAMATED DEVELOPMENT CO., INC.
t/a WASHINGTON PATENT OFFICE SEARCH
BUREAU and H. LAWRENCE BLASIUS,

Petitioners.

-against

COMMITTEE ON UNAUTHORIZED PRAC-
TICE, DISTRICT OF COLUMBIA COURT OF
APPEALS,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO
THE DISTRICT OF COLUMBIA COURT OF
APPEALS

*To the Honorable Chief Justice and the Associate Justices
of the Supreme Court of the United States:*

Your petitioners, Amalgamated Development Co., Inc.
t/a Washington Patent Office Search Bureau and H.
Lawrence Blasius, respectfully show:

Petitioners pray that a writ of certiorari issue to review
the final order and judgment of the District of Columbia
Court of Appeals entered in the above entitled action on
June 20, 1977.

OPINIONS OF THE COURTS BELOW

The opinion and order of the District of Columbia Court of Appeals, decided June 20, 1977 is marked Appendix A, hereto annexed. The said opinion and order affirmed a prior order made by one Judge of the District of Columbia Court of Appeals (Hon. John W. Kern, III), dated May 14, 1976, and marked Appendix B, hereto annexed.

JURISDICTION

The jurisdiction of this Court is invoked under Title 28 of the U.S. Code, Section 1254(1).

QUESTIONS PRESENTED

1. Does the recent decision of this Court in *Bates v. State Bar of Arizona*, 97 S.Ct. 2691 (decided June 27, 1977) compel a reversal of the Court below with regard to petitioner, H. Lawrence Blasius?

2. Does the case of *Hull v. United States*, 390 F.2d 462 (1968) indicate that the activities engaged in by the petitioner, Amalgamated Development Co., Inc., t/a Washington Patent Office Search Bureau are authorized and not contrary to any law?

3. Does this proceeding deal with matters related exclusively to Patent Law practice, which are vested exclusively in the Commissioner of Patents?

4. Does the District of Columbia Court of Appeals have the authority to enjoin the petitioners from engaging in their lawful business activities in Washington, D.C.?

5. Does the mere assistance in the preparation of patent applications for "pro se" applicants constitute the practice of law?

STATEMENT OF THE CASE

This proceeding was brought by the Committee on Unauthorized Practice of Law by means of a Petition and Order to Show Cause. The said Petition sought to have the Petitioners herein, Amalgamated Development Co., Inc., t/a Washington Patent Office Search Bureau and H. Lawrence Blasius, held in criminal contempt of court and/or permanently enjoined from holding themselves out as authorized or qualified to practice law in the District of Columbia. A copy of the Order to Show Cause and Petition is hereto annexed as Appendix C.

The Petitioners herein interposed an Answer to the Petition containing general denials with the admission that they are not admitted to practice law in the District of Columbia. Said Answer of the Petitioners also contained eight (8) separate affirmative defenses. A copy of said Answer is annexed as Appendix D.

Pursuant to order of the District of Columbia Court of Appeals, a hearing on this matter was held on January 2, 1976 before Hon. John W. Kern, III, Associate Judge, District of Columbia Court of Appeals. On May 14, 1976, Judge Kern made an Order herein containing Findings of Fact and Conclusions of Law (Appendix B). He concluded by ordering that the Petitioners herein be enjoined from:

"(1) giving legal advice as to inventors' rights in their inventions;

(2) advising inventors and potential patent applicants as to rights and procedures in filing applications for patents and in patenting inventions;

(3) rendering legal opinions as to patentability of inventions;

(4) recommending that clients proceed or not proceed with patent applications, file amendments

to rejected initial applications, and file additional amendments rather than appeal final rejections;

(5) preparing and drafting patent applications ready for applicants' signatures, preparing amendments to rejected patent applications, and employing or hiring others to do these tasks;

(6) otherwise engaging in the practice of law."

The Petitioners then filed a Petition for Review dated May 21, 1976 of the aforesaid Order of Judge Kern dated May 14, 1976. Briefs were then submitted on March 15, 1977 and a decision affirming Judge Kern was rendered on June 20, 1977 (Appendix A).

The pertinent and relevant factors involved herein are as follows:

At the outset, it was conceded that neither of the Petitioners named herein nor any of the persons connected with them are admitted to practice law in the District of Columbia. At the same time, it was also contended and was proved at the hearing that neither of the Petitioners named herein nor any of the persons connected with them are engaged in the practice of law in the District of Columbia or anywhere else.

The Petitioner, Amalgamated Development Co., Inc. t/a Washington Patent Office Search Bureau does conduct preliminary patentability searches for prospective inventors. The conducting of such searches has never been held to be a legal act or anything whatsoever to do with the practice of law. In fact, the patent searchers who actually conduct the searches at the United States Patent Office are rarely lawyers, but are mostly engineers or trained personnel in this particular field. The searching of patents has never been deemed to be a legal function of a lawyer. It is a highly technical field in which even many patent lawyers do not themselves engage, but have others to conduct such searches for them and their clients.

After conducting a search for a prospective inventor, the said Petitioners send the said person a report including copies of the nearest and closest patents already on file. In such letter, the said Petitioner, which does employ engineers and draftsmen on its staff, gives the inventor copies of the most pertinent and relevant patents located in its search in the U. S. Patent Office and then makes a statement as to whether they believe his invention or idea appears to be patentable. Here again, we have a purely technical opinion which is not at all legalistic. Such opinion is based only on the comparison of the structural and other features of one mechanical or other device with the structural features of a plurality of other mechanical devices. Such a process is a purely technical one, requiring, in the main, the services of an engineer, particularly a mechanical engineer or one trained in such technical matters. It does in no way involve or deal with a legal opinion.

Furthermore, the U. S. Patent Office itself maintains a roster of Registered Patent Attorneys and Agents who are permitted to represent and appear for inventors. However, the Patent Agents are mostly engineers and are not attorneys, even though they are entitled to do anything that a Patent Attorney can do within the Patent Office. Certainly, such Patent Agents, who are engineers, can tell inventors after a search that their invention "appears to be patentable." Such expression is deemed to be an expression of a technical opinion and not a legal one. If it was deemed to be legal opinion, then such Patent Agents who are not lawyers would be precluded and forbidden from rendering such opinion.

Accordingly, if it is held that said Petitioner is rendering a legal opinion by merely stating that an invention appears to be patentable, then all of the registered Patent Agents are also practicing law illegally. The fact is that such opinion is strictly a technical one when made by the

registered Patent Agents as well as when made by representatives of the said Petitioner. To hold otherwise would entail a definite form of discrimination.

The conclusion is inevitable that the work and services engaged in by said Petitioner is of a highly technical nature and cannot possibly be considered to be legal work or legal services of any nature.

It is also respectfully contended that the said Petitioner, besides conducting the aforesaid preliminary patentability searches, also is engaged in the business of furnishing assistance to applicants for patents who desire to file their own patent applications and appear "pro se", which they are legally authorized and entitled to do.

In other words, a line must be drawn between providing services or help to applicants who represent themselves, on the one hand, and representing applicants directly before the U. S. Patent Office, on the other. As long as the said Petitioner does not hold itself out as being registered or able to practice before the U. S. Patent Office, it is not doing anything wrong or illegal.

In fact, in their letters to inventors and prospective inventors, the said Petitioner specifically advises such applicants that they can obtain their own Patent Attorney or Agent if they wish or they can represent themselves in filing their respective applications for patent. The said Petitioner merely assists them in preparing their "pro se" applications. Such conduct has been held to be legal in Washington, D.C.

In fact, Hon. Erwin N. Griswold, former Solicitor General of the Department of Justice in December, 1968, in a Memorandum for The United States on a Motion to Dismiss the Writ of Certiorari in the case of *U.S. v. Blasius*, 393 U.S. 1008, 89 S. Ct. 615, 21 L. Ed. 557 (1969), made the following statement on page 2 of said Memorandum:

"Dismissal of the present case could long delay resolution of this issue. There could well be a tendency thereafter for individuals who wish to engage in the questionable practices to locate or relocate their activities in the apparent sanctuary of the District of Columbia. Further, criminal prosecutions in the District of Columbia would be of questionable propriety in the face of *Hull v. United States*, 390 F.2d 462 (C.A.D.C.), and there is no express provision in the statute for a civil remedy."

It should also be noted that a mere examination of the Yellow Pages of the telephone directories all over the country as well as many national magazines contain advertisements of many organizations and individuals who are engaged in the same or similar activities to those of said Petitioner. This type of business has been going on for a long time and has never in any jurisdiction been considered to be the practice of law.

Petitioners herein therefore respectfully contend that they are not in violation of Rule 46 II (b) of the General Rules of the District of Columbia Court of Appeals. It is submitted that what said Petitioners do and engage in their business does not and has never constituted the practice of law. Further, said Rule 46 II (b) does not apply to or control any practice or alleged practice before the U.S. Patent Office.

It is contended by the Petitioners that their acts and actions have been declared to be authorized in the District of Columbia by virtue of the determination and decision made in *Hull v. United States*, supra.

It is further submitted that the District of Columbia Court of Appeals, as well as its Committee on the Unauthorized Practice of Law, lack jurisdiction to entertain the instant matter because the power to admit persons to practice in patent matters before the U.S. Patent Office has been reserved by the United States

Constitution to Congress, and in turn by Congress it has been granted only to the Commissioner of Patents. It logically follows that since the said Court does not have power to authorize practice in patent matters before the U.S. Patent Office, it is unable to exercise any control over such practice.

From the above, it is established that the Commissioner of Patents has exclusive jurisdiction to determine what constitutes unauthorized practice before the U.S. Patent Office. Therefore, control of practice before the U.S. Patent Office is a superior right vested by the United States Constitution and by acts of Congress in the Commissioner of Patents, and this Court by virtue of Article VI of the United States Constitution, is bound thereby and precluded from interfering.

It might well be argued that even if the Petitioners herein were engaging in practice before the U.S. Patent Office, the said acts would not be an invasion of a right vested in an attorney by virtue of his franchise, to practice law in the District of Columbia, since such franchise does not authorize practice before the U.S. Patent Office.

REASONS FOR GRANTING THE WRIT

I

THE RECENT DECISION OF THIS COURT IN BATES v. STATE BAR OF ARIZONA, 97 S.Ct. 2691, COMPELS A REVERSAL OF THE COURT BELOW WITH REGARD TO PETI- TIONER, H. LAWRENCE BLASIUS.

The Petitioner, H. Lawrence Blasius, is by education and background a Chemical Engineer. He received the degrees of B. A. and B. S. in Chemical Engineering from Columbia University in 1948 and 1949, respectively. In 1950, he

passed the examination for registration to practice before the U.S. Patent Office and became a Registered Patent Agent. From 1950 to 1953, he worked in the field, preparing and prosecuting patent applications and in 1953 he opened his own office, in New York City. On July 1, 1959, new regulations in the U.S. Patent Office were promulgated and adopted which prohibited Registered Patent Attorneys and Agents from advertising. At that time, Mr. Blasius was engaged in a marketing service for inventions, and the success of his business required that he advertise. He, therefore, continued to advertise his services. On February 9, 1961, Mr. Blasius was suspended from practice before the U.S. Patent Office by reason of his advertising. (*In re Blasius*, 138 U.S.P.Q. 482 [Com. Pats. 1961]).

In view of the recent opinion of this Court in *Bates v. State Bar of Arizona*, 97 S. Ct. 2691 (decided June 27, 1977), it should be held that the regulation passed by the U.S. Patent Office prohibiting any advertising by Registered Patent Attorneys or Agents be declared null and void and be declared entirely ineffective and of no legal consequence.

Accordingly, the petitioner herein H. Lawrence Blasius, will be entitled to restoration of his former status as a Registered Patent Agent. Therefore, said petitioner can legally still be considered to be a Registered Patent Agent, as his exclusion to practice before the U.S. Patent Office on the sole ground of his advertising activities was not proper or in accord with law.

Since the aforesaid decision of this Court in *Bates v. State Bar of Arizona*, supra, came about after the final determination herein by the District of Columbia Court of Appeals (Appendix A), the question concerning the revived status of the petitioner, H. Lawrence Blasius, as a Registered Patent Agent was not raised in the Court below. However now that such advertising has been declared

lawful by this Court, the petitioner, H. Lawrence Blasius, will undoubtedly be restored as a registered Patent Agent.

Thus, the instant case with regard to the petitioner H. Lawrence Blasius, will fall squarely within the confines of the decision of this Court in *Sperry v. Florida*, 373 U.S. 379 (1963).

The District of Columbia Court of Appeals in its opinion herein (Appendix A), acknowledged the validity of the argument now being made:

"If petitioner Blasius were a registered patent agent/attorney, he would be correct under *Sperry*, in saying that the District of Columbia Committee on Unauthorized Practice has no power to forbid his activities."

If this Honorable Court does not see fit to entertain the instant Writ of Certiorari, then it is respectfully urged that the entire case be returned or remanded to the District of Columbia Court of Appeals for further study or review in light of the recent decision of this Court in *Bates v. State Bar of Arizona*, supra.

II

AN ANALYSIS OF THE CASE OF HULL V. UNITED STATES, 390 F. 2d 462 INDICATES THAT THE ACTIVITIES ENGAGED IN BY THE PETITIONER, AMALGAMATED DEVELOPMENT CO., INC., t/a WASHINGTON PATENT OFFICE SEARCH BUREAU ARE AUTHORIZED AND NOT CONTRARY TO ANY LAW.

In commenting on 35 U.S.C. 33, the *Hull* case, supra, stated that this section does not make registration with the U.S. Patent Office an essential condition of all gainful

employment in connection with the preparation of the patent applications. What this section punishes is misrepresentation as to one's status as a registered practitioner, not mere rendition of services by one who does not pretend to that status.

By virtue of the *Hull* decision, the Petitioner, Washington Patent Office Search Bureau has the right to perform in Washington, D. C. the tasks incident to helping or assisting others in the preparation and prosecution of patent applications before the U.S. Patent Office, just so long as they do not hold themselves out as registered or admitted to practice in the U.S. Patent Office.

The *Hull* case, supra, also discusses the Crampton bills, which never passed in Congress. On pages 464-465 of that decision, Circuit Judge McGowan states:

"In 1924 there was introduced in Congress the first of the so-called Crampton bills, which reappeared five times thereafter through 1932. As its language shows, it made it illegal not only to hold oneself out falsely as registered, but also 'to habitually air or assist' in the preparation of any patent application.

"The Crampton bills never passed, and one of the principal attacks made upon them was that they disabled all non-registered persons from providing any services in connection with the preparation of a patent application. When the bill that became the Lanham Act was first introduced in 1935, it did not sweep so broadly, as is clear from the testimony in support of it given by the Commissioner of Patents. The Lanham bill passed in 1937, without committee hearings but with a Senate Committee Report (No. 462, 75th Cong. 1st Sess.) that characterized the bill as 'not as sweeping as the familiar Crampton bill often introduced into Congress heretofore.' And on the floor of the

Senate, the sponsor of the Lanham Act was at pains to assure a leading opponent of the Crampton bills that the new measure fell far short of the latter's prohibition of all work on patent applications by non-registered persons."

And on pages 465-466, Circuit Judge McGowan discusses the word "qualified" as follows:

"In view of the legislative origins of that word, we believe that Congress has not as yet abandoned its reluctance, manifest in connection with the Crampton bills, to make registration with the Patent Office an essential condition of any and all gainful employment in connection with the preparation of patent applications. That is a policy which Congress might well adopt as necessary for the protection of the public, but it is not a policy for us to impose by a construction so at variance with the Congressional rejection of that policy thus far."

From the aforesaid quotations from the *Hull* case, supra, it is clear that the Court was well aware of the Congressional history involved in 35 U.S.C. 33. It is also important to take into consideration footnote #8, which appears on page 465 of said decision:

"8. The trial court defined 'qualified' as meaning 'fitted for a given purpose, competent, having complied with specific requirements of precedent conditions for an office or employment.' From this the trial court drew the conclusion that the words as used in the statute presented no ambiguity justifying resort to legislative history. But the definition which the trial court employed looks in both directions on the issues before us. One might conceivably be technically 'competent' to prepare a patent application without having complied with

the specific requirements for registration with the Patent Office."

And, on page 466 of said decision, the Court comes to the following conclusion:

"We, therefore, are of the view that what Section 33 punishes is misrepresentation as to one's status as a registered practitioner, and not the mere rendering of service by one who does not pretend to that status."

III

ANY QUESTION DEALING WITH ANY TYPE OF PATENT LAW PRACTICE IS VESTED IN THE COMMISSIONER OF PATENTS ONLY

It is respectfully contended that the Committee on Unauthorized Practice of the District of Columbia Court of Appeals does not have jurisdiction over any question dealing with or related to the practice of Patent Law. The same is exclusively reserved to the Commissioner of Patents.

Persons admitted to the practice of law in Washington, D. C. are not thereby qualified or authorized to practice in patent matters before the U.S. Patent Office. The power to admit persons to practice in patent matters before the U.S. Patent Office has been reserved by the Constitution of the United States to Congress, and in turn, Congress has granted the same only to the Commissioner of Patents.

Since the Washington, D.C. Courts do not have the power to authorize practice in patent matters before the U.S. Patent Office, they are therefore unable to exercise any control over such alleged practice.

The Commissioner of Patents therefore has exclusive jurisdiction to determine what constitutes unauthorized practice before the U.S. Patent Office.

Control of practice before the U.S. Patent Office is a superior right vested by the United States Constitution and by acts of Congress in the Commissioner of Patents; and the State Courts, including the Courts of the District of Columbia, by virtue of Article VI of the United States Constitution, are bound thereby and precluded from interfering herein.

The right to practice law conferred by a State or the District of Columbia is a special privilege in the nature of a franchise. However, practice before the U.S. Patent Office would not be an invasion of a right vested in an attorney by virtue of his franchise to practice law, since such franchise does not authorize practice before the United States Patent Office.

The cases of *Battelle Memorial Institute v. Green et al* and *In Re Battelle Memorial Institute (Unauthorized Practice of Law)*, both reported together in 29 Ohio Opinions (2d 388, (1962—Ohio Appeals Court, Tenth District, Franklin County), deal with the charge that the Battelle Memorial Institute, although not qualified to practice law and not admitted to the practice of law in Ohio, is nevertheless charged with engaging in the practice of law in Ohio.

The Court on the appeal held that a petition by the Unauthorized Practice of Law Committee of the State Bar Association seeking an injunction to prevent a non-profit corporation organized to conduct scientific research through the patent section of its legal department, from performing acts for its industrial sponsors claimed to constitute the practice of law does not grant jurisdiction to the Common Pleas Court to interfere with the superior right to control practice before the U.S. Patent Office, which Congress has vested in the Commissioner of Patents under authority of the United States Constitution.

In the *Battelle* cases, supra, the following clear and concise argument is set forth by the Court on pages 392 and 393, as follows:

"Normally, the practice of law is controlled exclusively by the judiciary. The reason why lawyers are officers of the court, and therefore subject to the control of the court, is that they are admitted by order of the court. However, persons admitted to the practice of law by the Ohio courts are not thereby qualified or authorized to practice in patent matters before the U.S. Patent Office. This power has been reserved by the United States Constitution to Congress, and, in turn, by Congress it has been granted only to the Commissioner of Patents. This leaves the Ohio courts in the position of being unable to exercise control over that which they do not have the power to authorize in the first instance."

* * *

"Were the courts of each state to control practice before the United States Patent Office, thus usurping a right to control that which they cannot authorize in the first instance, by considering it to constitute the practice of law within their state, then the courts of the 50 states, by ignoring the provisions of Article VI of the United States Constitution, supra, could render the provisions of Congress in regard to practice before the Patent Office as enacted under the provisions of Article I, Section 8, of the United States Constitution, supra, a nullity.

"It is our finding that the Commissioner of Patents, from the standpoint of unauthorized practice has exclusive right to determine whether the patent matters, in which Battelle participates through attorneys or agents employed by Battelle, are matters which constitute the business of Battelle due to a direct or primary interest of Battelle therein, or of Battelle by virtue of rights as an

assignee as provided for under Title 35, Section 152, or Rule 32, *supra*, and whether Battelle is engaged in unauthorized practice before the Patent Office.

"For the reasons set forth, we conclude that control of practice before the U.S. Patent Office is a superior right vested exclusively by the United States Constitution and by acts of Congress in the Commissioner of Patents, subject to appeal to the federal courts, and the state courts, by virtue of Article VI of the United States Constitution, are bound thereby and precluded from interfering."

The Court makes the following summary at page 394 in the *Battelle* cases:

"If the practices of Battelle, carried on through its agents or attorneys, in matters as to which the right of control has been reserved by the United States Constitution and Congress in the Commissioner of Patents, are to be questioned as being unauthorized practice in patent matters, the proceedings must be brought not before the Ohio courts but in the manner provided for by the acts of Congress passed under the authority of Section 8, Article I, of the United States Constitution and Rules of the Patent Commissioner, authorized by acts of Congress, as hereinbefore set forth. This power in the federal government is exclusive and a superior right granted by the United States Constitution to the Commissioner of Patents, and the judges in every state are bound thereby."

The aforesaid *Battelle* decision, *supra*, holds that the control of patent practice is wholly within the jurisdiction of the United States Commissioner of Patents, and that the same is not within the jurisdiction of the Ohio courts. Similarly, it must be held that control over the practice

related to patent matters is not within the jurisdiction of the District of Columbia Courts in our situation.

The case of *Silverman v. State Bar of Texas*, 405 F. 2d 410 (1968-5th Cir.) also holds that when a state law conflicts with an area covered by federal statutes enacted pursuant to constitutional authority, the federal policy may not be disregarded and its benefits denied by state law, even if the state law is enacted in exercise of otherwise clearly established state power.

On page 412 of that case, Circuit Judge Coleman stated:

"By statute, Congress has delegated to the United States Commissioner of Patents authority to 'prescribe regulations governing the recognition and conduct of agents, attorneys or other persons representing applicants or other parties before the Patent Office ***' 35 U.S.C.A. §31."

And, on page 413 of the *Silverman* case, *supra*, the Court succinctly held:

"At the outset, it might be well to note that federal patent laws, like other laws of the United States enacted pursuant to constitutional authority, are part of the supreme law of the land, and when state law touches on an area of those federal statutes, federal policy may not be set at naught and its benefits may not be denied by state law, even if the state law is enacted in the exercise of otherwise undoubted state power. The Supreme Court specifically so held in *Sears Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 84 S. Ct. 784, 11 L. Ed. 661 (1964), reh. den. 376 U.S. 973, 84 S. Ct. 1131, 12 L. Ed. 87"

The case of *Arnesen v. Raymond Lee Organization, Inc.*, 333 F. Supp. 116 (1971—D. C. Cal.) is further authority for holding that only the U.S. Patent Office can establish rules and regulations for practice before it which are

neither subject to nor subordinate to rules of practice of individual states. That case further held that the U.S. Patent Office has the power to establish criteria for practice as well as rules for disbarment and has authority to regulate all activities before it. At page 118 of the *Arnesen* case, supra, the same was clearly enunciated as follows:

"Chapter 3 of Title 35 regulates practice before the Patent Office. It is beyond question that that office can establish rules and regulations for practice before it which are neither subject to nor subordinate to the rules of practice of the individual states. *Sperry v. Florida*, 373 U.S. 379, 83 S. Ct. 1322, 10 L. Ed. 2d. 428 (1963). It follows that the Patent Office also has the power to establish criteria for practice as well as rules for disbarment and that it has plenary authority to regulate the patent bar."

See: *Enders v. American Patent Search Company, et al*, 535 F. 2d 1085 (1976—9th Cir.), cert. denied, 97 S. Ct. 242 (1976).

From the above authorities, it is respectfully contended that the Committee on Unauthorized Practice of the District of Columbia Court of Appeals does not have jurisdiction over any alleged practice before the U.S. Patent Office or over any type of practice in patent matters.

IV

WHAT PETITIONER, AMALGAMATED DEVELOPMENT CO., INC., t/a WASHINGTON PATENT OFFICE SEARCH BUREAU IS DOING IN ITS BUSINESS RELATIONSHIPS WITH PROSPECTIVE INVENTORS DOES NOT CONSTITUTE THE PRACTICE OF LAW.

After obtaining a preliminary patentability search, if it is believed that a product could command a market, the inventor is told that he can proceed with an application for patent. He is also specifically advised that the Washington Patent Office Search Bureau is NOT PATENT ATTORNEYS, and no where do they specify that the inventor need have his application serviced by them. In fact, the Washington Patent Office Search Bureau specifically tells him that he may use a Patent Attorney or Agent and that he need not use their organization. They do not state that they are qualified to perform such patent services or that they are admitted to practice before the U.S. Patent Office. In fact, they tell the inventor that he is filing his own application, "pro se". They merely state that they can and will assist him for a fee.

If the inventor chooses to use the services of the Washington Patent Office Search Bureau, he is sent for his signature a statement in which he states that he is aware of what he is doing.

As has heretofore been pointed out in this petition, the Washington, D. C. Courts are without jurisdiction over the Washington Patent Office Search Bureau in that the U. S. Patent Office has exclusive power and control over any question of admission to practice in the U. S. Patent Office, as well as the exclusive right to discipline those who practice or attempt to practice in said office. Moreover, the

practice before the U. S. Patent Office is done and regulated under rules and requirements of that office alone.

The case of *Sperry v. Florida*, supra, held that the State of Florida may not prohibit one who is not a lawyer from performing within the State tasks which are incident to the preparation and prosecution of patent applications before the U. S. Patent Office. In that case, the petitioner, Sperry, also rendered opinions as to patentability and prepared various instruments.

Our instant case, with regard to the petitioner, Washington Patent Office Search Bureau, is distinguished from the *Sperry* case, supra, because in our case, the said petitioner does not practice before the U. S. Patent Office and merely assists prospective inventors to file "pro se" applications. However, similar to our instant situation, the Florida Bar in the *Sperry* case, supra, instituted proceedings in the Supreme Court of Florida to enjoin certain conduct on the ground that it constituted the unauthorized practice of law. The *Supreme Court of Florida*, 140 So. 2d. 587, granted an injunction and the respondent therein brought certiorari to the United States Supreme Court. Chief Justice Warren, writing the unanimous opinion of the Court, held that the State of Florida could not enjoin a non-lawyer from performing and prosecuting applications in Florida, notwithstanding that such activity constituted the practice of law in Florida. This determination was made in view of the federal statute and U. S. Patent Office regulation authorizing practice before them by non-lawyers.

The *Sperry* case, supra, clearly stands for the proposition that the law of the state, though enacted in the exercise of powers not controvened, must yield when incompatible with federal legislation. That case also holds that the authority of Congress is no less when the state power which it displaces would otherwise have been exercised by the

state judiciary rather than the state legislature.

Another relevant case is *People v. Miller*, 23 A.D. 2d 144, 146, 147 (1965—1st Dept.) which dealt with a proceeding brought by the Attorney General of the State of New York to enjoin one, Carl Miller, from using the words "Patent Attorney", even though he was only duly admitted as a "Patent Agent". In commenting on Section 270 of the Penal Law of the State of New York, Mr. Justice Eager, in speaking for the Court stated:

"The section 270 proscription against the use by a non-lawyer of the title 'attorney' is not general or all-inclusive. By its express provisions, a violation of the section depends upon whether or not the non-lawyer used the title 'in such manner as to convey the impression that he is a legal practitioner of law or in any manner to advertise that he either alone or together with any other person or persons has, owns, conducts, or maintains a law office or a law and collection office of any kind for the practice of law.'

"The defendant by virtue of Federal statute and regulation, has the right to perform within the State the tasks incident to the preparation and prosecution of patent applications before the United States Patent Office and to use the designation 'patent attorney' in this connection. The State law may not be construed or applied to interfere with such Federal right. (See *Sperry v. Florida*, 373 U. S. 379, supra.)"

As heretofore noted, the petitioner, Washington Patent Office Search Bureau, at no time files any document with the U. S. Patent Office. It is always signed and filed by the inventor, who is acting "pro se" or as his own attorney of record. Neither the Washington Patent Office Search Bureau, nor any of its employees, appear or take any action

in respect to such matters in any of the courts of the United States or of the several states, or act on behalf of the inventor, before any government body.

All that the petitioner, Washington Patent Office Search Bureau, does is to assist in the preparation of the technical drawings and application from the material sent or submitted by the inventor. Whatever is done by the petitioner, Washington Patent Office Search Bureau, is sent to the inventor for his approval. It is the inventor's application and he must approve it before he files it. The entire services performed by the petitioner, Washington Patent Office Search Bureau, are of a technical nature usually done by a draftsman or engineer in the office of a registered Patent Attorney or Agent. It cannot possibly be considered to be a legal document.

V

PREPARATION OF PATENT APPLICATIONS OR THE HOLDING OUT OF BEING ABLE OR QUALIFIED TO PREPARE SUCH AP- PLICATIONS IS NOT A VIOLATION OF SECTION 33 AND DOES NOT CONSTITUTE THE PRACTICE OF LAW.

Congress did not say that if a person is unregistered, that person may not perform patent services. It said that if a person is not registered, he may not represent to others that he is registered or indicate that he has official approval of any sort.

This distinction is a clear one, found in other certifying schemes. For example, in the District of Columbia, any person is permitted to act as an accountant, but only a person certified as a public accountant is permitted to hold himself out as a certified public accountant. *District of Columbia Code*, Title 2, Section 2-901, 902, 909 (1961 ed.).

See also: *District of Columbia Code*, Title 2, Section 2-1101, 1102, 1114 (1961 ed.).

It should be noted that the Government itself uses non-registered personnel to prepare and prosecute patent applications in the U. S. Patent Office. For example, in a bulletin put out by the United States Civil Service Commission announcing an examination for Patent Adviser, a description of the work performed by such Patent Advisers, who are not necessarily registered or admitted to practice before the Patent Office, is given on page 2 of said bulletin as follows:

"DESCRIPTION OF WORK

Patent Advisers perform professional work related to *inventions and patents* including, for example, the study and analysis of descriptions, drawings, and models of inventions and the investigation of earlier patents, inventions and technical literature to determine the advisability of filing patent applications thereon and to ascertain the scope of such applications; *the preparation of patent applications and their prosecution in the U. S. Patent Office, including preparing amendments*, affidavits, and other responsive documents, filing appeals to the Patent Office Board of Appeals, and assisting in the conduct of interference proceedings; the investigation in the Patent Office of the prior knowledge in a particular field, as evidenced by earlier inventions, patents and technical literature, for use by Signal Corps scientists and engineers in carrying out their assigned research and development projects more expeditiously, economically and effectively; the investigation of claims of patent infringement made against the U. S. Government; and consultation with civilian and military officials on patent and related matters." (Emphasis added).

Announcement No. 2-21-3 (1960), issued: March 23, 1960. Open Continuously, X-118 Modified. Army—Fort Monmouth, N. J. MON 863-60.

In still another bulletin put out by the United States Civil Service Commission, also announcing an examination for the position of Patent Adviser, which position does not require one to be registered or admitted to practice before the Patent Office, the following description of duties for said position appears on page 1 of said bulletin:

"DESCRIPTION OF DUTIES: Patent advisers *perform professional scientific or engineering work related to patents.* Such work includes the analysis of inventions, the determination of patentability, and *the preparation and prosecution of applications for patents.* The work also involves making validity and infringement investigations, prosecuting appeals in the U.S. Patent Office, and serving in an advisory capacity to administrative and legal officers on patent matters. The work requires the knowledge of one of the fields outlined above, and of Patent Office procedures, patent law, and applicable precedents." (Emphasis added). Announcement No. AT 35-1 (65) X-118 GS-1221. Issued 1/6/65.

Thus, it is obvious that many governmental employees who prepare patent applications are not registered to practice before the U.S. Patent Office. In other words, the Government is doing even more than the Petitioner. Amalgamated Development Co., Inc. t/a Washington Patent Office Search Bureau, herein is doing. The Government is doing some of the very same acts which the said Petitioner is here accused of doing. In fact, the Government via the United States Civil Service Commission is advertising for personnel to prepare patent applications even though such personnel is not registered or admitted to practice before the U. S. Patent Office.

As clearly appears herein, the Government has its own non-registered people doing these services of preparing patent applications every day. If the Government itself is not violating any law, then certainly the said Petitioner is not violating any.

The Petitioners in this case have not been excluded from assisting inventors by any law or statute. The U. S. Patent Office itself is well aware of and recognizes the fact that persons like the Petitioners herein will continue to advertise their ability to assist inventors. The U. S. Patent Office has never referred to such conduct as illegal or in violation of the law. In fact, in a bulletin put out by the U. S. Patent Office entitled "General Information Concerning Patents," June 1960 (Reprint of November 1963), in a section headed "Attorneys and Agents", the following paragraph is contained on page 11 thereof:

"Some patent attorneys and agents formerly advertised their services in magazines, particularly popular magazines of a mechanical or technical nature, and in telephone books. By regulation, registered patent attorneys and agents are now forbidden to advertise for patent business. Some individuals and organizations that are not registered advertise their services in the field of patent searching and patent promotion. Such individuals and organizations cannot represent inventors before the Patent Office. They are not subject to Patent Office discipline and the Office cannot assist inventors in dealing with them."

From a reading of the above, it becomes clear that the U.S. Patent Office has never been able to persuade Congress that the non-registered attorney and the technician should not be allowed to assist inventors. The only laws in this respect that the Patent Office has been able to have enacted are Sections 11a and 33 of Title 35, U.S.C.

Accordingly, it must be concluded that the general attorney and the technician, as well as the Petitioners in this case, have the legal right to assist inventors in the preparation of applications for patent. Therefore, no crime or unlawful practice of law has been committed by the Petitioners herein.

CONCLUSION

For the above stated reasons, it is respectfully submitted that the petition for writ of certiorari be granted.

Respectfully submitted,

HARRY GROSSMAN
Attorney for Petitioner
515 Madison Avenue
New York, N.Y. 10022
Tel.: (212) 752-4220

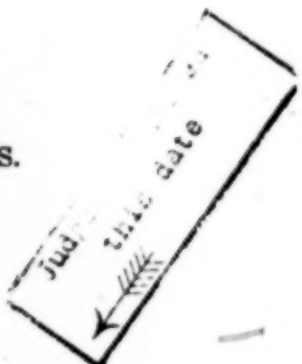
DISTRICT OF COLUMBIA COURT OF APPEALS

No. 10907

IN RE:

AMALGAMATED DEVELOPMENT CO., INC.,
t/a Washington Patent Office Research
Bureau and H. LAWRENCE BLASIUS, PETITIONERS.

Petition for Review of an Order of
Judge John W. Kern, III,
Associate Judge,
D.C. Court of Appeals



(Submitted March 15, 1977

Decided June 20, 1977)

Harry Grossman for petitioners.

Edgar T. Bellinger, Chairman, Committee on Unauthorized Practice of Law.

Before KELLY, GALLAGHER and MACK, Associate Judges.

KELLY, Associate Judge: H. Lawrence Blasius and Amalgamated Development Co., Inc., here seek review of an order enjoining them from practicing law in the District of Columbia after a hearing in which the following facts were found.¹

¹ The present proceeding began with a petition to this court filed by the Committee on Unauthorized Practice under D.C. App. R. 46 II(b) (8). This committee was established by Rule

Petitioner Blasius is the principal owner and operator of Amalgamated Development Co., Inc., trading as the Washington Patent Office Search Bureau, a District of Columbia corporation.² He is not, nor does he hold himself out to be, a member of the District of Columbia bar or licensed to practice before the United States Patent Office.

Petitioner places advertisements in such publication as Popular Science Magazine offering to conduct patentability searches for and to advise inventors on patent matters. When a response to an advertisement is received, petitioner initially writes the inventor describing the procedure for conducting a patentability search, and advising the inventor to have the application for such a search witnessed by a friend to prove that he is the "first and true inventor." The letter warns an inventor not to attempt to market his ideas until he has an application pending in the Patent Office.

When the inventor sends in a "disclosure" of his invention, petitioner conducts a patentability search in the Patent Office. Copies of the prior art revealed by the search are sent to the inventor and an opinion on patentability is offered.³ If petitioner concludes that the idea is

46 II(a) by the court, which was promulgated pursuant to D.C. Code 1973, §§ 11-2501, -2504. The chief judge of the court issued two orders: one designating an associate appellate judge to act as a hearing judge and the second ordering respondents to show cause why they should not be adjudged in contempt of court and/or permanently enjoined from the challenged activities. After making the findings enumerated above, an injunction issued.

² For the sake of clarity, we refer to petitioners in the singular.

³ Whether an invention is patentable depends upon whether it meets the statutory criteria set forth in 35 U.S.C. §§ 101-

not patentable, the client is so advised and it is recommended that no more money be spent developing the inventor's idea. If in the petitioner's opinion the idea appears patentable, it is recommended that a patent be applied for and assistance is offered the client in preparing the application. If the inventor agrees to enlist the services of petitioner, the application, oath, and formal drawings are prepared and sent to the inventor with instructions to file them in the Patent Office pro se together with the \$65.00 filing fee. The Patent Office communicates directly with the inventor in all further correspondence.

If the application is rejected, as it usually is at least once, petitioner assists the client in amending the specification and claim to overcome Patent Office objections. When and if the application is finally rejected, petitioner recommends that the client file another amendment rather than an appeal and again offers to assist in preparing the amendment. Petitioner is paid for his services.

It is argued in this petition for review that jurisdiction over any question related to the practice of patent law is vested exclusively in the Commissioner of Patents and that, in any event, the enjoined activities do not constitute the practice of law.

I.

Any person may deal directly with the Patent Office in his own behalf in prosecuting an application for letters patent. 37 C.F.R. § 1.31 (1976).⁴ To represent another be-

103 (1970 & Supp. V 1975), viz., among other things, whether it is novel, useful, and unobvious.

⁴ The Rules of Practice, which are regulations promulgated by the Commissioner of Patents pursuant to statutory au-

fore the Commissioner of Patents, however, the requirements set out in the regulations established by the Commissioner pursuant to 35 U.S.C. § 31 (Supp. V 1975), i.e., 37 C.F.R. §§ 1.341, -342 (1976), must be met. Two categories of persons are licensed to practice before the Patent Office—patent attorneys (§ 1.341(a)) and patent agents (§ 1.341(b)). The only difference between the two is that patent agents are not also attorneys. Both must otherwise meet the same requirements, and once registered have the same scope of authority.⁵ The fact that one is an attorney does not of itself qualify one to practice patent law.

As we shall discuss, *infra*, much of the activity engaged in by a patent agent/attorney (and by petitioner) concerns the practice of law. *Sperry v. State of Florida*, 373 U.S. 379 (1963); *In re Cowgill*, 37 Ohio App. 2d 121, 307 N.E.2d 919 (1973). Thus, many nonlawyer/patent agents are actually practicing law in the state where they are situated. Such practice is unauthorized by state bar associations which have in the past attempted to curtail it, but the Supreme Court has resolved the conflict between the federal license to practice before the Patent Office and state regulations limiting the practice of law to attorneys in *Sperry v. State of Florida, supra*. The Court, in a unanimous opinion, based its decision on the Supremacy Clause, U.S. CONST. art. 6, stating:

The statute [35 U.S.C. § 31 (1952)] thus expressly permits the Commissioner to authorize

thority, have the force and effect of law. *Application of Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (1959), *cert. denied*, 362 U.S. 903 (1960).

⁵ In fact, before 1938 all registrants were registered as attorneys whether they were attorneys at law or not. 37 C.F.R. § 1.341(i) Note (1954).

practice before the Patent Office by nonlawyers, and the Commissioner has explicitly granted such authority. If the authorization is unqualified, then, by virtue of the Supremacy Clause, Florida may not deny to those failing to meet its own qualifications the right to perform the functions within the scope of the federal authority. A State may not enforce licensing requirements which, though valid in the absence of federal regulation, give "the State's licensing board a virtual power of review over the federal determination" that a person or agency is qualified and entitled to perform certain functions, or which impose upon the performance of activity sanctioned by federal license additional conditions not contemplated by Congress. "No State law can hinder or obstruct the free use of a license granted under an act of Congress." . . . [*Id.* at 385; (footnotes omitted).]

Thus, the State of Florida could not prevent a nonattorney who was a licensed patent agent from conducting his practice before the Patent Office in Florida. The obvious corollary of this principle is that if the federal government has *not* granted a license in this area, a state is free to enforce its own licensing regulations.⁶

Our case is identical with *In re Cowgill, supra*, where the practitioner was neither registered to practice before the Patent Office nor a member of the bar. The Ohio Court of Appeals held that the state was free to proceed

⁶ The Supremacy Clause protects only those activities of registrants "necessary for the accomplishment of the federal objectives." *Sperry v. State of Florida, supra* at 402.

against him for the unauthorized practice of law,⁷ stating:

There is no federal purpose to protect those whom it [the federal government] does *not* license from further regulation by the state. The objective is to protect the right to practice before the U.S. Patent Office from restraint by the states. [*Id.* at 124, 307 N.E.2d at 922.]

If petitioner Blasius were a registered patent agent/attorney, he would be correct, under *Sperry*, in saying that the District of Columbia Committee on Unauthorized Practice has no power to forbid his activities. But he is not so registered,⁸ as he freely concedes; therefore *Sperry* does not apply. And when a petitioner is not registered in the Patent Office a state does not interfere with any federal purpose in subjecting the practitioner to its own licensing regulations and is free to do so.

Petitioner argues, however, that because only the Commissioner has the power to authorize practice before the Patent Office *only* the Commissioner can determine what constitutes unauthorized practice and take action against it.

⁷ It is well settled that the state has a valid interest in preventing nonlawyers from engaging in the practice of law. *Konigsberg v. State Bar of California*, 366 U.S. 36, 40-41 (1961).

⁸ Apparently Blasius became a Registered Patent Agent in 1950. Unfortunately he persisted in soliciting business through advertising, even after a regulation was passed in 1959 prohibiting advertising by registered patent agents/attorneys. (37 C.F.R. § 1.345 (1976)) As a consequence, he was excluded from practice before the Patent Office in 1961, *In re Blasius*, 138 USPQ 482 (Comr. Pats. 1961), and has since that time been engaged in the business described above. *United States v. Blasius*, 397 F.2d 203, 204 (2d Cir.), *cert. granted*, 393 U.S. 950 (1968), *cert. dismissed*, 393 U.S. 1008 (1969).

It is undisputed that the Commissioner has jurisdiction over persons, registered or not, who hold themselves out as qualified to prepare or prosecute patent applications. Proceedings to suspend, disbar, or exclude a registrant from practice are before the Commissioner. 37 C.F.R. § 1.348 (1976). The Commissioner can also criminally prosecute nonregistrants under 35 U.S.C. § 33 (Supp. V 1975), which provides:

Whoever, not being recognized to practice before the Patent and Trademark Office, holds himself out or permits himself to be held out as so recognized, or as being qualified to prepare or prosecute applications for patent, shall be fined not more than \$1,000 for each offense.

Nevertheless, there is no authority for petitioner's argument that because the Commissioner can punish unauthorized practice before the Patent Office, a state is precluded from concurrently preventing the unauthorized practice of law. No case cited by petitioner is on point. In *Battelle Memorial Institute v. Green*, 93 Ohio Law Abs. 516, 29 Ohio Op. 2d 388 (1962), the practitioner was a registered patent agent, whereas petitioner is not. *Silverman v. State Bar of Texas*, 405 F.2d 410 (5th Cir. 1968), holds that a state bar regulation prohibiting a registered patent attorney from being listed both as a general attorney and a patent attorney unduly interfered with the Patent Office's interest in having its licensees make their specialty known and was thus invalid under *Sperry*. Both *Enders v. American Patent Search Company*,⁹ 535 F.2d 1085 (9th Cir.), *cert. denied*, — U.S. —, 97 S. Ct. 242 (1976), and *Arnesen v. Raymond Lee Organization, Inc.*, 333 F. Supp. 116 (C.D.

⁹ One of the defendants in *Enders* was Harold Lawrence Blasius.

Cal. 1971), were prosecutions under 35 U.S.C. § 33 and there was no discussion in either opinion of simultaneous proceedings under state law.¹⁰

The subject was discussed in *In re Cowgill*, *supra* at 124, 307 N.E.2d at 922, however, where the court said:

Some claim is made that the federal government has preempted the regulation of those *not* admitted to practice before the Patent Office by the passage of Section 33, Title 35 U.S. Code, which makes it a criminal offense for a person not so registered to hold himself out, or permits himself to be held out as so recognized, or as being qualified to prepare or prosecute applications for patent. However, the action of a state in forbidding the acts here enjoined neither prevents a federal prosecution under this section, nor impedes the federal government from acting against those who, *besides* engaging in the practice of law, violates this statute. The action of the state is at the most parallel to the federal action and not in opposition to it. [Emphasis in original.]

We are thus of the opinion that regardless of any action taken by the Commissioner of Patents under § 33, this court has jurisdiction to review and enjoin petitioner's activities.

II.

Petitioner also argues, citing *Hull v. United States*, 129 U.S.App.D.C. 47, 390 F.2d 462 (1968), that the challenged activities do not constitute the practice of

¹⁰ The two cases are significant, however, in that they establish a private right of action under 35 U.S.C. § 33 (Supp. V 1975), a fact which further undermines petitioner's theory of exclusive jurisdiction in the Commissioner of Patents.

law. As the hearing judge noted, however, the *Hull* case is irrelevant to the proceeding before the court.

In *Hull*, there was a criminal prosecution under 35 U.S.C. § 33, and while it was not stated in the opinion whether or not defendant Hull was a member of the bar, she was not registered in the Patent Office. The issue in the case was the interpretation of the word "qualified" in § 33; *i.e.*, whether it means (a) possessing particular skill or know-how in performing certain functions or tasks or (b) having formal legal authority to do those tasks, *i.e.*, registered to practice before the Patent Office. The court decided that it meant the latter, whether such holding out is explicit or implied.¹¹ It said that § 33 was intended to punish "misrepresentation as to one's status as a registered practitioner, and not the mere rendering of service by one who does not pretend to that status." *Id.* at 51, 390 F.2d at 466. The section was not meant to prevent any and all "gainful employment in connection with the preparation of patent applications." *Id.*

Petitioner appears to argue that his activities are not proscribed by § 33, under *Hull*, because he does not hold himself out to be registered to practice before the Patent Office and therefore is not engaged in the practice of law. Even assuming that petitioner has not violated § 33, we fail to see how this fact could lead to the conclusion that he is not practicing law. *Hull* says nothing whatever about whether acts found to violate § 33 are also considered the practice of law, there being no discussion

¹¹ The court paraphrased § 33 as follows:

Whenever anyone who is not registered with the Patent Office says he is, or, without saying so directly, employs methods which give the impression that he is, he may be criminally punished. [*Id.* at 51, 390 F.2d at 466.]

at all concerning the relationship between the practice of law and practice before the Patent Office. Thus petitioner cannot seriously argue that *Hull* in any way supports the contention that he is not practicing law.¹²

On the contrary, it has been held that activities such as petitioner's constitute the practice of law, *e.g.*, advising inventors as to patentability under 35 U.S.C. §§ 101-103 (1970 & Supp. V 1975), based on the results of the search; preparing the patent application including the specification claims, 35 U.S.C. § 112 (Supp. V 1975), and official drawings, 35 U.S.C. § 113 (Supp. V 1975); advising of what action to take after rejection, including after final rejection; and preparing and filing amendments. *Sperry v. State of Florida, supra* at 383; *In re Cowgill, supra* at 122, 307 N.E.2d at 920. Because petitioner does not sign any correspondence with the Patent Office and disclaims that he and his organization are patent attorneys does not remove these efforts from the realm of the practice of law.

¹² Furthermore, the validity of the *Hull* decision is questionable. In *United States v. Blasius, supra*, the Second Circuit rejected the *Hull* interpretation of § 33. Instead it held that 'qualified' "carries its primary and more ordinary meaning of possessing particular skill or 'know-how' in performing certain tasks or functions" *Id.* at 206. This seems more consistent with the legislative intent to protect inventors by setting a high standard of professional competence for the patent bar (which includes patent agents). *Arnesen v. Raymond Lee Organization, Inc., supra* at 118.

Because of the conflict the Supreme Court granted certiorari in the *Blasius* case to decide whether (1) the *Blasius* court erred in holding that, contrary to *Hull*, the language in § 33 was clear and not ambiguous; and (2) whether the word 'qualified' means skill, or formal legal authority from the Patent Office to engage in patent practice. Certiorari was dismissed voluntarily by the parties under Rule 60 of the Supreme Court Rules.

We are of the opinion that this court and its Committee on Unauthorized Practice have jurisdiction over petitioner's conduct notwithstanding the Commissioner of Patent's concurrent jurisdiction and, additionally, that the findings of fact of the hearing judge are amply supported by the record and his conclusions of law are correct. Accordingly, the order enjoining petitioners from continuing the unauthorized practice of law is

Affirmed.

APPENDIX "B"

ORDER DATED MAY 14, 1976

DISTRICT OF COLUMBIA COURT OF APPEALS
Miscellaneous No. 17-75In re:
AMALGAMATED DEVELOPMENT CO., INC.
t/a WASHINGTON PATENT OFFICE SEARCH
BUREAU, and H. LAWRENCE BLASIUS.

Respondents.

ORDER

This matter comes before this hearing judge for consideration on the petition of the Committee on the Unauthorized Practice of Law filed pursuant to Rule 46 II(b)(8) of the General Rules of the District of Columbia Court of Appeals. On December 5, 1975, the District of Columbia Court of Appeals issued two orders; one order designated a hearing judge, and the second order directed respondents to show cause why they should not be adjudged in criminal contempt of court and/or permanently enjoined, and further set the date of oral argument. Said orders were premised on the petitioner's allegations that respondents were engaged in the unauthorized practice of law in connection with the preparation and filing of patent applications with the United States Patent Office and the rendering of legal advice as to the patentability of clients' inventions and procedures in seeking patents.

After hearing and considering the testimony and other evidence adduced in open court, and the legal arguments asserted, the hearing judge enters the following findings of facts and conclusions of law.

FINDINGS OF FACT

1. Respondent Amalgamated Development Co., Inc., trading as the Washington Patent Office Search Bureau, [hereinafter Bureau] is a District of Columbia corporation engaged in business in the District of Columbia, and maintains an office at 734 15th Street, N.W., Washington, D.C. (Answer.) Respondent H. Lawrence Blasius is the principal owner and operator of the Bureau. (Tr. 13, 56). Respondent Blasius works regularly in the office in the District of Columbia. (Tr. 29-30).

2. Neither respondent is a member of the District of Columbia Bar, and neither respondent has been admitted to the practice of law in the District of Columbia either by the United States District Court for the District of Columbia prior to April 1, 1972, or by the District of Columbia Court of Appeals. (Answer.)

3. Neither respondent is currently licensed or admitted to practice by the United States Patent Office in accordance with 35 U.S.C. §32 and 37 C.F.R. § 1.341. (Petitioner's Ex. No. 1.) However, respondent Blasius was for a period of ten years a registered patent agent authorized to practice before the Patent Office. (Tr. 80.) His registration was revoked. *See In re Blasius*, 128 U.S.P.Q. 482 (1961).

4. Neither respondent holds itself out as being admitted to the practice of law in the District of Columbia or as being registered or admitted to practice before the United States Patent Office. (Petitioner's Ex. No. 10).

5. Respondents place advertisements in Popular Science Magazine and other magazines offering to conduct patent searches to determine if an invention or idea appears to be patentable. These advertisements also offer a free "Invention Protection Form" and patent information. (Petitioner's Ex. No. 2 at p. 162; Respondent's Ex. No. 1 at p. 179.)

6. As a result of these advertisements, prospective inventors write to respondents for information about how to proceed with the handling and promotion of their inventions or ideas. (Tr. 16). Respondents then send back initial information to the inventors, advising them of the steps necessary to have a patentability search conducted on the invention to determine the novelty and potential patentability of the invention. (Tr. 17; Petitioner's Ex. No. 3).

7. The initial letter sent by respondents in response to inquiries advises inventors that they may have their application for a patent search witnessed by a friend, so that the witnessed form "can be used as legal evidence at any time in the future to prove that you are the first and true inventor." This letter also cautions inventors that at this stage "no attempt should be made to sell your invention, since under our present laws you have nothing to sell (no legal property), until an application for patent has actually been filed in the Patent Office and you have *PATENT PENDING*." (Petitioner's Ex. No. 3).

8. Pursuant to this initial letter, inventors send to respondents "disclosures" on the enclosed forms plus payment for a patent search. These disclosures describe how the invention works and include rough drawings of the invention itself, allowing a search to be made to determine if the invention appears to be patentable. (Tr. 17-18, 84.)

9. Respondents conduct preliminary patentability searches for prospective inventors who request them. These searches are conducted by employees and independent contractors hired by respondents who investigate similar existing patents on file in the United States Patent Office to determine whether other patents anticipate the idea that the inventor wants to patent. (Tr. 15-16, 89). The patent searcher also finds the patents which appear to him to be the closest to the invention or idea submitted by the prospective inventor. (Tr. 21, 89).

10. Upon conclusion of the patentability search, respondents send their clients a report including copies of patents already on file with the United States Patent Office which are most like the clients' inventions or ideas. (Petitioner's Ex. No. 5.) In this report, respondents make a statement as to whether they believe the invention or idea appears to be patentable. (Tr. 21).

11. The opinion as to whether an invention or idea is patentable is made by respondent Blasius after considering the results of the patent search. (Tr. 20-21, 76, 91). The decision is based on a comparison of the structural and other features of the invention or idea with the features of other existing and patented inventions, (Tr. 64) as well as on a judgment whether, under the statutory criteria, sufficient novelty is shown in the invention or idea to warrant a patent. (Tr. 15-16).

12. In the event respondents conclude, based on the preliminary patent search, that the invention or idea does not appear to be sufficiently new and different from existing patents, respondents inform the prospective inventor of this adverse finding and suggest that the inventor not spend any more money attempting to develop this invention or idea. (Petitioner's Ex. No. 13, 14).

13. In the event that respondents conclude that the invention or idea appears to be patentable, respondents urge the prospective inventor to proceed with the preparation and filing of a patent application in order to establish a legal right to the invention or idea. Respondents recommend that the inventor proceed as a pro se applicant, and offer to assist the inventor in so doing by preparing the application, specifications, claims, and official patent drawings required by the United States Patent Office. (Petitioner's Ex. No. 5) Respondents advise these potential applicants that it is not necessary to employ the services of a patent attorney. (Tr. 25)

14. Respondents inform potential applicants that their

rights if the invention is patented are limited to the United States and its territories only, and that the publication of a United States patent bars subsequent patenting in Canada. Respondents offer to file the inventor's application in Canada in order to protect the invention in Canada. (Petitioner's Ex. No. 8)

15. When an inventor decides to employ the services of respondents, he pays a retainer fee and returns to respondents the copies of the patents located during the patent search. (Tr. 22). Respondents then send the material to technical employees in New York who prepare and photocopy drawings of the invention for the inventor's approval. (Tr. 22-23). The patent application is prepared by respondents, and it includes an abstract of the specifications of the invention. (Tr. 23)

16. Respondents forward the completed application form and drawings to the inventor, along with an oath, a petition ready for signature, and instructions on how to file as a pro se applicant by mailing the materials directly to the Commissioner of Patents with the \$65 filing fee. (Tr. 23; Petitioner's Ex. No. 8). The United States Patent Office then communicates directly with the pro se applicant. (Tr. 24-26)

17. In many cases the patent application is rejected the first time it is submitted. (Tr. 25) Many of respondents' clients then contact respondents to ask what the next step should be. Respondents advise them that an amendment to the application must be prepared, redefining the scope of the invention and rewording and narrowing the claims made in order to overcome the objections cited by the Patent Office. (Tr. 27)

18. Respondents advise their clients as to the procedure for filing amendments and offer their services in preparing them. (Tr. 27) Respondents also inform the applicants that if no action is taken within three months, the application becomes abandoned (Tr. 27-28).

19. Respondents use the same employees in New York who prepare the original drawings to prepare amendments to rejected patent applications. (Tr. 28-29). Respondents mail the revised documents to their clients, instructing them to sign them and forward a copy to the Commissioner of Patents. (Tr. 29)

20. In the event a client receives a final rejection from the Patent Office after the amended application is filed, respondents advise their clients that they can appeal the final rejection to the Board of Appeals in the Patent Office or that they can file another amendment. Respondents recommend that the applicants file another amendment rather than appeal, and respondents offer to prepare this second amendment. (Tr. 29; Petitioner's Ex. No. 11).

21. The majority of correspondence between respondents and their clients is by way of form letters prepared by respondent Blasius. (Tr. 30, 57)

22. Respondents are paid for their services (Petitioner's Ex. No. 3, 5, 8, 11).

CONCLUSIONS OF LAW

1. The District of Columbia Court of Appeals has jurisdiction to prevent and punish any unauthorized practice of law occurring within the District of Columbia that is not otherwise authorized or allowed by federal legislation. *See Sperry v. Florida*, 373 U.S. 379, 383-85, 402 (1963). This jurisdiction is derived from a statutory grant of power to the court to make rules regulating the qualifications of and disciplining members of the District of Columbia Bar, D. C. Code 1973, §§11-2501 to -2504, and from the inherent power of the court to "regulate and control the practice of law and to protect the public and the administration of justice by forbidding the unwarranted intrusion of unauthorized and unskilled persons into the practice of law." *J.H. Marshall & Associates, Inc. v.*

Burleson, D.C. App., 313 A. 2d 687, 692 (1973) (Footnote omitted).

2. Rule 46 II is a valid implementation of the power of the District of Columbia Court of Appeals to regulate the practice of law in the District of Columbia. Rule 46 II(b) prohibits any person from regularly engaging in the practice of law in the District of Columbia unless he is an enrolled active member of the Bar. The practice of law includes, but is not limited to:

[A]ppearing for a person other than himself as attorney in any court, or preparing deeds, mortgages, contracts, assignments, discharges, leases, trust instruments or any other instruments affecting real or personal property or any interest therein, or preparing wills, codicils, or any other instruments affecting the disposition of property or decedents' estates, or preparing pleadings of any kind in any action brought before any court, or preparing or expressing formal opinions or consulting with respect to any of the foregoing or on any other matters of law. (Rule 46 II (b)(3)).

3. The unauthorized practice of law constitutes a contempt of court and may be punished by fine or imprisonment for contempt after appropriate proceedings. Unauthorized practice also may be enjoined. See D.C. App. R. 46 II(b)(8).

4. Certain activities engaged in by respondents, viz.: (1) giving advice at various stages of the patenting process as to inventors' rights in their inventions under the law; (2) informing inventors of the procedure for patenting inventions and advising inventors as to subsequent steps to take if the patent application is rejected; (3) considering and rendering opinions as to the patentability of inventions within the statutory criteria; (4) advising clients whether or not to proceed with a patent application in an attempt to

protect the invention; (5) preparing and drafting patent applications ready for signature, including drawings, claims and specifications; (6) advising applicants of the steps to take to file the application with the United States Patent Office and of the procedures involved, (7) recommending that applicants file amendments after rejection of their initial patent applications; (8) preparing amendments to rejected patent applications; (9) hiring employees and independent contractors to prepare patent applications and amendments; (10) informing clients of their right to appeal final rejections by the United States Patent Office but recommending instead that they file another amendment; and (11) charging and collecting fees for legal services rendered by respondents and respondents' employees, constitute the unauthorized practice of law in the District of Columbia.

5. The decision of the Supreme Court in *Sperry v. Florida*, 373 U.S. 379 (1963), does not prevent the District of Columbia Court of Appeals from prohibiting respondents from engaging in "this circumscribed form of patent practice." *Id.* at 383. In *Sperry*, the Court held that the State of Florida could not prohibit the petitioner's activity because those activities were expressly permitted by a federal statute, 35 U.S.C. §31, which authorizes nonlawyer patent agents to practice before the Patent Office. Since respondents here are not admitted to practice before the Patent Office as patent agents, denying to respondents, who fail to meet the qualifications specified in the rules of the District of Columbia Court of Appeals, the right to perform certain patent-related functions does not "hinder or obstruct the free use of a license granted under an act of Congress." *id.* at 385, and hence is valid.

As the Supreme Court commented in *Sperry*:

We do not question the determination that under Florida law the preparation and prosecution of patent applications for others constitutes the

practice of laws Nor do we doubt that Florida has a substantial interest in regulating the practice of law within the State and that, in the absence of federal legislation, it could validly prohibit nonlawyers from engaging in this circumscribed form of patent practice. (Footnote omitted).

6. The decision of the Court of Appeals for the District of Columbia Circuit in *Hull v. United States*, 1229 U.S. App. D.C. 47, 390 F. 2d 462 (1968), does not prevent the District of Columbia Court of Appeals from prohibiting respondents from or punishing respondents for unauthorized practice of law. The defendant in *Hull* was prosecuted for a criminal violation of 35 U.S.C. §33, which provides:

Whoever, not being recognized to practice before the Patent Office, holds himself out or permits himself to be held out as so recognized, or as being qualified to prepare or prosecute applications for patent, shall be fined not more than \$1,000 for each offense.

Since the respondents here are not accused of violating this statute, the limiting interpretation made by the Circuit Court is irrelevant to this proceeding. Respondents may be correct in asserting that their conduct has been held lawful under 35 U.S.C. §33 by the decision in *Hull*, but their conduct is nonetheless unauthorized practice of law, and consequently is subject to sanction by the District of Columbia Court of Appeals. The fact that respondents do not hold themselves out as attorneys or as registered patent agents authorized to practice before the United States Patent Office does not mean that respondents are not engaged in the unauthorized practice of law in the District of Columbia.

In consideration of the above findings of fact and conclusions of law, the hearing judge, this 14th day of May,

1976, orders that respondents be and hereby are enjoined from:

(1) giving legal advice as to inventors' rights in their inventions;

(2) advising inventors and potential patent applicants as to rights and procedures in filing applications for patents and in patenting inventions;

(3) rendering legal opinions as to patentability of inventions;

(4) recommending that clients proceed or not proceed with patent applications, file amendments to rejected initial applications, and file additional amendments rather than appeal final rejections;

(5) preparing and drafting patent applications ready for applicants' signatures, preparing amendments to rejected patent applications, and employing or hiring others to do these tasks;

(6) otherwise engaging in the practice of law.

s/John W. Kern, III
JOHN W. KERN, III
Associate Judge
D.C. Court of Appeals

May 14, 1976

APPENDIX "C"**ORDER TO SHOW CAUSE****DISTRICT OF COLUMBIA COURT OF APPEALS**

In Re:

**AMALGAMATED DEVELOPMENT CO., INC.,
t/a WASHINGTON PATENT OFFICE SEARCH
BUREAU, and H. LAWRENCE BLASIUS,**

Respondents.

Miscellaneous No. 17-75

Upon consideration of the petition of the Committee on Unauthorized Practice of Law for an Order to Show Cause why the respondents Amalgamated Development Co., t/a Washington Patent Office Search Bureau, and H. Lawrence Blasius, should not be adjudged in criminal contempt of court, and/or permanently enjoined,

IT IS HEREBY ORDERED, that respondents Amalgamated Development Co., Inc., t/a Washington Patent Office Search Bureau, and H. Lawrence Blasius, appear before this Court on Friday, January 9, 1976, at 10 a.m., or as soon thereafter as they can be heard, to show cause, if any they have, why they should not be adjudged in criminal contempt of court and/or enjoined for the reasons set forth in said petition, and that respondents file their answer to the petition by January 2, 1975.

By the Court:
s/Gerald McNeilly
Chief Judge

Dated this 5th day of December, 1975.

PETITION FOR ORDER TO SHOW CAUSE**DISTRICT OF COLUMBIA COURT OF APPEALS**

In Re:

**AMALGAMATED DEVELOPMENT CO., INC.,
t/a WASHINGTON PATENT OFFICE SEARCH
BUREAU, and H. LAWRENCE BLASIUS, 734
15th Street, NW., Washington, D.C. 20005**

Respondents.

Comes now the Committee on Unauthorized Practice of Law and respectfully petitions for an Order to Show Cause why the respondents Amalgamated Development Co., Inc., t/a Washington Patent Office Search Bureau, and H. Lawrence Blasius, should not be held in criminal contempt of court and/or permanently enjoined, and respectfully represents to this honorable Court as follows:

1. That the respondents maintain an office at 734 15th Street, N.W., Washington, D. C.; that they are not members of The District of Columbia Bar; and that they are not persons admitted to practice law in the District of Columbia either by the United States District Court for the District of Columbia prior to April 1, 1972, or by this Court. That said respondents are engaged in a business involving processing and review of various alleged inventions in behalf of clients for the purpose of determining whether the same may or may not be patentable by the United States Patent Office including searching patent records to discover inventions that are the same or similar to those of their clients; that said respondents compare their clients' alleged inventions with similar ones found either by themselves or persons employed by them for that purpose and then advise their clients as to the patentability

of their alleged inventions; that said respondents prepare patent applications for their clients and advise them as to the procedural steps involved in pursuing patents for their alleged inventions before the United States Patent Office and the courts; that respondents review unfavorable decisions of the United States Patent Office concerning their clients, advise them pertaining thereto, and prepare amended applications for such clients in an effort to meet the objections of the United States Patent Office; and that respondents receive fees for their services.

2. That notwithstanding that respondents have not been admitted to practice law in the District of Columbia nor to practice by and before the United States Patent Office, they have and are engaging in the practice of law in the District of Columbia particularly in the representation of persons in connection with the preparation and filing of patent applications with the United States Patent Office and in the rendering of legal advice as to the patentability of clients' inventions and procedures in seeking patents.

WHEREFORE, it is respectfully requested that the Court grant the following relief:

1. Issue forthwith an Order to Show Cause directing respondents to appear before this Court on Friday, January 9, 1976, at 10 a.m. or as soon thereafter as counsel can be heard, to show cause, if any they have, why they should not be adjudged in criminal contempt of court for engaging in the practice of law in the District of Columbia, and/or holding themselves out as authorized or qualified to practice law in the District of Columbia and/or permanently enjoined from such further conduct.

2. Order that a copy of this petition and an Order to Show Cause be forthwith delivered to the United States Marshal for service upon the respondents personally, and that respondents file their answer to the petition by January 2, 1975.

3. Order such further relief as may be just and proper.

Committee on Unauthorized
Practice of Law
By s/Edgar T. Bellinger
Edgar T. Bellinger, Chairman
700 Brawner Building
888 Seventeenth Street, NW
Washington, D.C. 20006
298-8600

APPENDIX "D"

ANSWER TO PETITION

DISTRICT OF COLUMBIA COURT OF APPEALS

In re:

AMALGAMATED DEVELOPMENT CO., INC.,
t/a WASHINGTON PATENT OFFICE SEARCH
BUREAU and H. LAWRENCE BLASIUS, 734
15th Street, N.W., WASHINGTON, D.C. 20005.

Respondents.

The Respondents, above-named, by their attorney, HARRY GROSSMAN, appear herein and respectfully interpose this Answer to the Petition for Order to Show Cause obtained by the Committee on Unauthorized Practice of Law.

FIRST: Deny each and every allegation contained in paragraph designated "1" of the Petition herein, except admit that the Respondent, AMALGAMATED DEVELOPMENT CO., INC., t/a WASHINGTON PATENT OFFICE SEARCH BUREAU maintains an office at 734 15th Street, N.W. Washington, D.C., and further admit that neither Respondent herein are admitted to practice law in the District of Columbia either by the United States District Court for the District of Columbia prior to April 1, 1972, or by this Court.

SECOND: Deny each and every allegation contained in paragraph designated "2" of the Petition herein.

AS AND FOR A FIRST SEPARATE, COMPLETE AND DISTINCT AFFIRMATIVE DEFENSE.

THIRD: That neither of the Respondents named herein are engaged in the practice of law in the District of Columbia or anywhere else, nor do they render any legal advice.

FOURTH: The Respondent, AMALGAMATED DEVELOPMENT CO., INC., t/a WASHINGTON PATENT OFFICE SEARCH BUREAU does conduct preliminary patentability searches for prospective inventors.

FIFTH: That the actual work in the conducting of such preliminary patentability searches is done by trained persons, who are not themselves lawyers, and who also conduct such searches for lawyers, business firms and others.

SIXTH: That the patent searchers who actually conduct the searches at the United States Patent Office are rarely lawyers, but are mostly engineers or trained personnel in this particular field which is highly technical and in which most patent lawyers do not themselves engage, but have others to conduct such searches for them and their clients.

SEVENTH: That patent searches are conducted on behalf of prospective inventors by many and numerous individuals, firms and organizations who regularly advertise the availability of their services in the Yellow Pages of the telephone directory as well as in numerous magazines.

EIGHTH: That the conducting of such searches has never been held to be a legal act or anything whatsoever to do with the practice of law and has never been deemed to be a legal function of a lawyer.

AS AND FOR A SECOND SEPARATE, COMPLETE AND DISTINCT AFFIRMATIVE DEFENSE.

NINTH: That after having a preliminary patentability search conducted for a prospective inventor, the Respondent, AMALGAMATED DEVELOPMENT CO., INC., t/a WASHINGTON PATENT OFFICE SEARCH BUREAU sends the said person a report including copies of the nearest and closest patents already on file.

TENTH: That in such letter, the said Respondent, who does employ engineers and draftsmen on its staff, gives the prospective inventor copies of the most pertinent and relevant patents located in its preliminary patentability search in the United States Patent Office and then makes a statement as to whether they believe his invention or idea appears to be patentable.

ELEVENTH: The said opinion is a purely technical one and is not at all legalistic and is based only on the comparison of the structural and other features of one mechanical or other device with the structural or other features of a plurality of other mechanical or other devices.

TWELFTH: That such a technical process requires, in the main, the services of an engineer, particularly a mechanical engineer or one trained in such technical matters and the same in no way involves or deals with a legal opinion nor can the same possibly be considered to be a legal opinion or legal advice and the United States Patent Office itself only hires engineers to act as Examiners in their office who do the same type of work.

AS AND FOR A THIRD SEPARATE, COMPLETE AND DISTINCT AFFIRMATIVE DEFENSE:

THIRTEENTH: That the United States Patent Office maintains a roster of Registered Patent Attorneys and Agents who are permitted to represent and appear for inventors, but the Patent Agents are mostly engineers and are not attorneys, even though they are permitted and entitled to do anything that a Patent Attorney can do within the United States Patent Office.

FOURTEENTH: That said Patent Agents, who are not attorneys, are permitted to tell prospective inventors that their invention or idea appears to be patentable, which is an expression of a technical opinion and not a legal one.

FIFTEENTH: That if the Respondent, AMALGAMATED DEVELOPMENT CO., INC., t/a WASHINGTON PATENT OFFICE SEARCH BUREAU was restrained or enjoined from stating that an invention or idea appears to be patentable on the ground that the same constitutes the practice of law in the District of Columbia, then all of the registered Patent Agents would also have to be restrained and enjoined from similarly practicing law illegally.

SIXTEENTH: That such opinion or advice to the effect that an invention or idea appears to be patentable is merely a technical one when made by the registered Patent Agents or by said Respondent, and to hold otherwise herein would be discriminatory and unjust.

**AS AND FOR A FOURTH SEPARATE,
COMPLETE AND DISTINCT AFFIRMATIVE
DEFENSE:**

SEVENTEENTH: That the Respondent, AMALGAMATED DEVELOPMENT CO., INC., t/a WASHINGTON PATENT OFFICE SEARCH BUREAU, besides conducting preliminary patentability searches, is engaged in the business of furnishing and rendering assistance to applicants for patents who desire to file their own patent applications and wish to appear "pro se", which they are legally authorized and entitled to do.

EIGHTEENTH: The said Respondent does not appear for or represent such or any applicants before the United States Patent Office nor does said Respondent hold itself out as being registered or able to practice before the United States Patent Office.

NINETEENTH: That, in fact, in their letters to prospective inventors, the said Respondent advises them that they can obtain their own Patent Attorney or Agent if they wish or they can represent themselves in filing their respective applications for patent, and the said Respondent merely assists them in preparing their "pro se" applications.

TWENTIETH: That such conduct engaged in by the Respondent herein has been held to be permissible, legal and in accordance with law by this Court in *Hull v. United States*, 390 F. 2d 462 (C.A.D.C.) (1968).

**AS AND FOR A FIFTH SEPARATE, COM-
PLETE AND DISTINCT AFFIRMATIVE
DEFENSE:**

TWENTY-FIRST: That the Petition herein deals exclusively with matters related to Patent Law practice and

the same is vested only in the Commissioner of Patents by virtue of the United States Constitution and by Acts of Congress.

TWENTY-SECOND: That the Courts in Washington, D.C. do not have the power to authorize practice in patent matters before the United States Patent Office and they are therefore unable to exercise any control over such alleged practice.

TWENTY-THIRD: That the right to practice law conferred by a State or the District of Columbia is a special privilege in the nature of a franchise, but practice before the United States Patent Office would not be an invasion of a right vested in an attorney by virtue of his franchise to practice law, since such franchise does not authorize practice before the United States Patent Office.

TWENTY-FOURTH: That, by reason of the aforesaid, neither this Court nor its Committee on Unauthorized Practice of Law have jurisdiction over any alleged practice before the United States Patent Office or over any type of patent matter including the subject matter of this Petition.

**AS AND FOR A SIXTH SEPARATE, COM-
PLETE AND DISTINCT AFFIRMATIVE
DEFENSE:**

TWENTY-FIFTH: That the Committee on Unauthorized Practice of Law is designated by and is really an arm of the same Court hearing this matter, and therefore the Court herein is acting as both prosecutor and Judge in this proceeding.

TWENTY-SIXTH: That such dual role as is assumed by the Court herein is improper and unconstitutional, and deprives the Respondents of their rights.

**AS AND FOR A SEVENTH SEPARATE,
COMPLETE AND DISTINCT AFFIRMATIVE
DEFENSE:**

TWENTY-SEVENTH: That the Petition herein seeks to hold the Respondents in criminal contempt even though the said Respondents have never been found in violation of any law, statute or order of this or any other Court and no finding of impropriety or misconduct has ever been made against these Respondents even though hearings have heretofore been held before the Committee on Unauthorized Practice of Law.

TWENTY-EIGHTH: That the said relief sought herein is improper and unwarranted and is based on a wrong premise, namely that the Respondents herein have already been adjudged guilty of some wrongful or illegal conduct.

**AS AND FOR AN EIGHTH SEPARATE,
COMPLETE AND DISTINCT AFFIRMATIVE
DEFENSE:**

TWENTY-NINTH: That the Respondent, H. LAWRENCE BLASIUS, named in the Petition herein does not in his individual capacity engage in any business activity or enterprise whatsoever in Washington, D. C. and is, in fact, a resident of New York City.

THIRTIETH: That, accordingly, this Court does not have any jurisdiction whatsoever over the Respondent, H. LAWRENCE BLASIUS.

WHEREFORE, the Respondents respectfully pray that the Petition herein be dismissed and the relief sought therein be denied in all respects.

s/HARRY GROSSMAN
HARRY GROSSMAN
Attorney for Respondents